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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,440	07/18/2006	Futoshi Nakabe	2006_00836A	5602
52349	7590	08/13/2008	EXAMINER	
WENDEROTH, LIND & PONACK L.L.P. 2033 K. STREET, NW SUITE 800 WASHINGTON, DC 20006			KELLY, RAFFERTY D	
		ART UNIT	PAPER NUMBER	
		2876		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/586,440	NAKABE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	RAFFERTY KELLY	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 June 2008 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>20060718</u> .	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-16 are objected to because of the following informalities: all of the claims inherit a problem that exists in claim 1. This problem is in the last clause of the claim. This feature makes a distinction between "the identifier determined by the identifier determination unit" and "the identifier held in the determined identifier storage unit". Clearly if the identifier has been determined, it must be held in a storage area, which is the determined identifier storage unit. Thus, the determined identifier and the identifier held in the determined identifier storage unit are in fact the same. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by "Identification cards - Contactless integrated circuit(s) cards – Proximity cards" (XP-001146902) (See submitted NPL document). In the following rejections, this reference will be referred to as "14443-3".

Regarding claims 1 and 13-16, 14443-3 teaches a contactless card that communicates with a reader/writer after being supplied with electric power, comprising:

a power detection unit operable to detect electric power enough to communicate with the reader/writer (7.4.3 and 7.4.5); an identifier determination unit operable to determine an identifier that identifies the contactless card (6.4.4 or 7.9.2), every time the power detection unit detects the enough electric power (7.9, 7.9.2 - REQB powers the card up, and ATQB is sent upon receipt of REQB, ATQB contains identifier); a determined identifier storage unit operable to hold the identifier determined by the identifier determination unit (this feature is inherent in 14443-3 because the identifier is created and manipulated by the card, thus it must be stored somewhere); a receiving unit operable to receive, from the reader/writer, a command requesting that the identifier that identifies the contactless card should be sent to the reader/writer (6.3.1 or 7.4.5); a sending unit operable to send, to the reader/writer, the identifier determined by the identifier determination unit, and stored in the determined identifier storage unit (7.4.1 – “Send ATQB”).

Regarding claim 2, 14443-3 teaches the contactless card according to claim 1, as shown above. 1444—3 further teaches wherein the identifier determination unit is operable to generate an identifier every time the power detection unit detects the enough electric power (7.9, 7.9.2 - REQB powers the card up, and ATQB is sent upon receipt of REQB, ATQB contains identifier), and to determine the generated identifier as the identifier that identifies the contactless card (UID - 6.4.4 or PUPI - 7.9.2)

Regarding claim 3, 14443-3 teaches the contactless card according to claim 2, as shown above. 14443-3 further teaches wherein the identifier determination unit is

operable to generate the identifier made up of a fixed value portion and a random number portion (UID 6.4.4 is partially random).

Regarding claim 4, 14443-3 teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches a candidate identifier storage unit operable to hold candidate identifiers (both UID and PUPI can be stored on card), wherein the identifier determination unit is operable to select one of the candidate identifiers held in the candidate identifier storage unit every time the power detection unit detects the enough electric power, and to determine the detected candidate identifier as the identifier that identifies the contactless card (Either REQA or REQB powers the card up and the identifier (ATQA or ATQB) depends upon which REQ is sent).

Regarding claim 5, 14443-3 teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the identifier determination unit is operable to determine the identifier using a random number (UID 6.4.4 uses random numbers).

Regarding claim 6, 14443-3 teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches a communication end detection unit operable to detect an end of a communication between the reader/writer and the receiving unit and the sending unit (7.4.6 - reception of REQB), wherein the identifier determination unit is operable to determine a new identifier and the determined identifier storage unit is operable to hold the new identifier in the case where the communication end detection unit detects the end of the communication (7.4.1 – “Wait for Matched ATTRIB

or HLTB", from this step a REQB ends current communication and starts over, requiring a new ATQB/identifier).

Regarding claim 7, 14443-3 teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches wherein the communication between the reader/writer and the contactless card is in compliance with the ISO/ICE1443 (title page of 14443-3), and the identifier sent by the sending unit is set as a Pseudo-Unique Proximity Integrated Circuit Card Identifier included in a response to a request command that is sent from the reader/writer to the contactless card (7.9.2).

Regarding claim 8, 14443-3 teaches the contactless card according to claim 1, as shown above. 14443-3 further teaches a mode judgment unit operable to judge an operation mode in which the card operates (card judges whether it is operating in mode 'A' or mode 'B' by what kind of REQ it receives); a random identifier generation unit operable to generate an identifier in a random manner (ATQA/UID is random – 6.4.4); and a specific identifier generation unit operable to generate a specific identifier (ATAB/PUPI - 7.9.2), wherein the identifier determination unit is operable to determine one of the following identifiers as the identifier that identifies the contactless card based on the judgment made by the mode judgment unit: the identifier generated by the random identifier generation unit; and the identifier generated by the specific identifier generation unit (based on whether REQA (6.4.1) or REQB (7.4.1) is received).

Regarding claim 9, 14443-3 teaches the contactless card according to claim 8, as shown above. 14443-3 further teaches wherein the operation mode includes: an inspection mode indicating that the contactless card is in an inspection process; and a

use mode indicating that the contactless card is in use by a public user. These two specific modes are merely intended use and do not provide any further structure to the claims, as such, any two modes used in a card are sufficient to meet these particular limitations. In the present 14443-3 reference, the two modes, A and B, require the same structure as the modes presented in the claims, and thus read on the claimed modes. 14443-3 further teaches the identifier determination unit is operable to determine, in mode B, that the identifier generated by the specific identifier generation unit is the identifier that identifies the contactless card (REQB/ATQB is the first mode), and to determine, in mode A, that the identifier generated by the random identifier generation unit is the identifier that identifies the contactless card (REQA/ATQA is the second mode).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over 14443-3 in view of Nakabe et al. (US 2003/0094491).

Regarding claim 10, 14443-3 teaches the contactless card according to claim 8, as shown above.

14443-3 lacks the specifics of the memory.

Nakabe et al. teaches wherein the specific identifier generation unit is operable to generate the identifier based on information stored in a read only memory where information stored therein is not rewritable [0062].

It would have been obvious to one of ordinary skill in the art at the time of invention to use ROM to store the identifier information because it allows for very reliable and secure storage when compared to other memory types.

4. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over 14443-3 in view of Guenther (US 6111951).

Regarding claims 11 and 12, 14443-3 teaches a contactless card according to claim 8, as shown above.

14443-3 lacks the specifics of the memory.

Guenther teaches wherein the specific identifier generation unit is operable to generate the identifier based on information stored in a non-volatile memory where information stored therein is rewritable, wherein the non-volatile memory is one of an electrically erasable programmable read only memory (Col. 6 Lines 7-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use EEPROM to store the identifier because EEPROM allows for data that can be altered and written (allowing for a more dynamic identifier), but also will be saved when not being powered.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAFFERTY KELLY whose telephone number is (571)270-5031. The examiner can normally be reached on Mon. - Fri. 800-1730 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. K./  
Examiner, Art Unit 2876  
8/7/08

/Michael G Lee/  
Supervisory Patent Examiner, Art Unit 2876